

REMARKS

Claims 1-8 and 11 have been amended and new claims 12-20 have been added.

Applicant respectfully requests further examination and reconsideration of claims 1-20, now pending in the application.

The Office Action mailed from the Patent Office on November 30, 2004 has been carefully considered and indicates that:

- a) Claims 1-6 and 9-11 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Smith in view of Castiglia *et al.*; and
- b) Claims 7 and 8 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

In response to the Examiner's objection to claims 7 and 8 as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims, applicant greatly appreciates the Examiner's indication of the allowable subject matter of claims 7 and 8 and has accordingly added new claim 20 to include the substance of base claim 1 and the substance of allowable claim 7.

In response to the Examiner's rejection of claims 1-6 and 9-11 under 35 U.S.C. § 103(a) as being unpatentable over Smith in view of Castiglia *et al.*, applicant has:

1. Amended claims 1-6 and 11.
2. Added new claims 12-19.

Pursuant to 37 CFR § 1.111(c), amended claim 1 discloses the following advantageous distinctive feature that distinguishes over and avoids the prior art:

"an inner circumference of said at least one vertical support is lined with current carrying conductors"[Emphasis added]

The operative word in the advantageous distinctive feature of amended claim 1 discussed *supra* is "lined."

In order to properly interpret the operative word "lined" of amended claim 1 discussed *supra*, applicant relies upon *Altiris, Inc., v. Symantec Corp.*, 318 F.3d 1363, 65 USPQ.2d 1865 (Fed. Cir. 2003), where the court held:

"If a claim term has an established meaning, then that is the meaning that controls...."[Emphasis added]

And, an established meaning can be shown from a dictionary definition, as was decided in *CCS Fitness, Inc. v. Brunswick Corp.*, 288 F.3d 1359, 62 USPQ.2d 1658 (Fed. Cir. 2002), where the court held:

“Dictionary definition...may be used to show that the term has a generally understood meaning....”[Emphasis added]

Applying the *CCS Fitness, Inc. v. Brunswick Corp.* decision discussed *supra* to the case at hand, it is revealed that the American Heritage® Dictionary of the English Language, Fourth Edition defines:

LINED:

“to cover the inner surface of”[Emphasis added]

When the lighting system for conducting an electrical current of amended claim 1 is designed in accordance with the advantageous distinctive feature of amended claim 1 discussed *supra*, the system has the following advantages, *inter alia*:

1. A need for snaking loose wires through the at least one vertical support (trunk) is eliminated.
2. A need for physically splicing the plurality of current carrying rods (branches) to the current carrying conductors in the at least one vertical support is eliminated.
3. There are no loose wires in the at least one vertical support to deal with.

Even though the advantageous features of amended claim 1 discussed *supra*, and any others discussed throughout the instant amendment, may not have been disclosed and discussed specifically in the specification of the patent application as it was originally filed, they still must be relied upon as evidence of patentability, as was decided in *In re Chu*, 66 F.3d 292, 36 USPQ.2d 1089 (Fed. Cir. 1995), where the court held:

"Because the Board was required to consider the totality of the record, the Board was not free to disregard the evidence and arguments presented by Chu in response to the obviousness rejection. Additionally, the Board erred in apparently requiring Chu's evidence and arguments responsive to the obviousness rejection to be within his specification in order to be considered. To require Chu to include evidence and arguments in the specification regarding whether placement of the SCR catalyst in the bag retainer was a matter of "design choice" would be to require patent applicants to divine the rejections the PTO will proffer when patent applications are filed." [at 1094] [Emphasis added]

"We have found no cases supporting the position that a patent applicant's evidence and/or arguments traversing a § 103 rejection must be contained within the specification. There is no logical support for such a proposition as well, given that obviousness is determined by the totality of the record including, in some instances, most significantly, the evidence and arguments proffered during the give-and-take of ex parte patent prosecution." [at 1095] [Emphasis added]

So it can be seen *supra* that the configuration of the current carrying conductors lining the inner circumference of the at least one vertical support of amended claim 1 is not merely a matter of design choice, but is significant and of critical importance. It therefore must be considered in determining patentability, as was decided in *In re Dailey and Eilers*, 149 USPQ 47 (CCPA 1976), where the court held that the configuration of a device must be considered in determining patentability if the configuration is significant:

"Appellants have presented no argument which convinces us that the particular configuration of their container is significant or is anything more than one of numerous configurations a person of ordinary skill in the art would find obvious for the purpose of providing mating surfaces in the collapsed container of Matzen. See *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459." [Emphasis added]

Turning now to the references, and particularly to Smith, in contradistinction, Smith does not teach "an inner circumference of said at least one vertical support is lined with current carrying conductors"[Emphasis added] as required by the advantageous distinctive feature of amended claim 1 discussed *supra*, but rather Smith teaches that the electrical wires **80** and **81** thereof [relied upon as the current carrying conductors of amended claim 1] are free of the inner circumference of the tree sections [relied upon as the at least one vertical support of amended claim 1] and hang freely in the tree sections as shown in **FIGURE 4** of Smith and as discussed at col. 1, lines 53-55, col. 2, lines 24-26, and claim 7, lines 1-3 of Smith, respectively, where it is disclosed:

"The tree section may be hollow. There may be electrical wiring in the hollow tree sections."[Emphasis added]

"The center shaft...may be hollow enabling electrical wiring to pass therein."
[Emphasis added]

"...said center shaft...[is] hollow enabling electrical wiring to pass therein."
[Emphasis added]

This arrangement of Smith is critical to Smith because Smith advocates that this arrangement is a unique feature of its invention as discussed at col. 5, lines 8-10 of Smith, where it is disclosed:

"This view [FIG. 4] shows the electrical wiring within the tree section which is also a unique feature of this invention."
[Emphasis added]

Even though this arrangement of Smith is supposedly unique, it still has the following disadvantages, *inter alia*:

1. A need for snaking loose wires through the center shafts (trunk) is required.
2. A need for physically splicing the wiring in the branches to the wiring in the center sections is required.
3. There are loose wires in the center sections to deal with.

Regarding amended claims 2 and 6 and new claim 12, applicant respectfully draws the Examiner's attention to the fact that the Federal Circuit holds that relevant case law must be relied upon in determining obviousness; the determination of

obviousness is a matter of law, as was decided in *In re Deuel*, 51 F.3d 1552, 1557, 34 USPQ.2d 1210 (Fed. Cir. 1995), where the court held:

"Obviousness is a question of law, which we review de novo, though factual findings underlying the Board's obviousness determination are reviewed for clear error. In re Vaeck, 947 F.2d 488, 493, 20 USPQ2d 1438, 1442 (Fed. Cir. 1991); In re Woodruff, 919 F.2d 1575, 1577, 16 USPQ2d 1934, 1935 (Fed. Cir. 1990)."[at 1214][Emphasis added]

And, as was upheld in *Richardson-Vicks Inc. v. The Upjohn Co.*, 122 F.3d 1476, 44 USPQ.2d 1181 (Fed. Cir. 1997), where the court held:

"The difficulty with RVI's position is that, although the argument has merit when the issue is purely one of fact, it does not follow when the issue involves a question of law. It is black letter law that the ultimate question of obviousness is a question of law. See Graham v. Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966) (citing Great A. & P. Tea Co. v. Supermarket Equip. Co., 340 U.S. 147, 155, 87 USPQ 303, 309 (1950)); In re Donaldson Co., 16 F.3d 1189, 1192, 29 USPQ2d 1845, 1848 (Fed. Cir. 1994) (in banc); Texas Instruments Inc. v. Unit States Int'l Trade Comm'n, 988 F.2d 1165, 1178, 26 USPQ2d 1018, 1028 (Fed. Cir. 1993). And we review that legal question without deference to the trial court. See Gardner V. TEC Sys. Inc., 725 F.2d 1338, 1344, 220 USPQ 777, 782 (Fed. Cir. 1984) (district court's conclusion on obviousness is one of law and subject to full and independent review in this court)."[at 1183][Emphasis added]

Applying the case law discussed *supra* to the case at hand, applicant respectfully directs the Examiner to the seminal case of *Graham v. John Deere Co.*, 383 U.S. 1, 17, 148 USPQ 459, 467, 15 L.Ed.2d 545, 86 S.Ct. 684 (1966) where the Supreme Court articulated the requirements for a *prima facie* holding of obviousness. The Patent Office has since set forth in *MPEP* § 706.02, a three step requirement for establishing a *prima facie* case of obviousness.

The first step requires that the Examiner must set forth the differences in the claim over the applied references. The second step requires that the Examiner must set forth the proposed modification of the references which would be necessary to arrive at the claimed subject matter. And, the third step requires that the Examiner must explain why the proposed modification would be obvious.

The courts require that in order to satisfy the third step for establishing a *prima facie* case of obviousness, the Examiner must identify where the prior art provides a motivating suggestion to make the modification proposed in the second step for establishing a *prima facie* case of obviousness, as was decided in *In re Jones*, 958 F.2d 347, 21 USPQ.2d 1941 (Fed. Cir. 1992), where the court held:

"The Solicitor points out that, given the breadth of forms of dicamba (free acid, ester, or salt) disclosed by Richter as having herbicidal utility, one of ordinary skill in the art would appreciate that the dicamba group has significance with respect to imparting herbicidal activity to dicamba compounds. Thus, the solicitor contends, one skilled in the art would have been motivated to use, with dicamba, substituted ammonium salts made from a known amine, such as the

amine disclosed by Zorayan and Wideman, and would have expected such a salt to have herbicidal activity. Before the PTO may combine the disclosures of two or more prior art references in order to establish *prima facie* obviousness, there must be some suggestion for doing so, found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598-99 (Fed. Cir. 1988). We see no such suggestion in Zorayan, which is directed to shampoo additives, nor Wideman, which teaches that the amine used to make the claimed compound is a byproduct of the production of morpholine. Nor does the broad disclosure of Richter fill the gap, for the reasons discussed above." [at 1943-44][Emphasis added]

And, as was upheld in *Gambro Lundia AB v. Baxter Healthcare Corporation*, 110 F.3d 1573, 42 USPQ.2d 1378 (Fed. Cir. 1997), where the court held:

"...the record must provide a teaching, suggestion, or reason to substitute computer-controlled valves for the system of hoses in the prior art. The absence of such a suggestion to combine is dispositive in an obviousness determination. See *SmithKline Diagnostics, Inc. v. Helena Lab. Corp.*, 859 F.2d 878, 886-87, 8 USPQ2d 1468, 1475 (Fed. Cir. 1998)"[at 1383][Emphasis added]

In this same regard, the Examiner's attention is respectfully drawn to the decisions in *Heidelberger Druckmaschinen AG v. Hantscho Commercial Products, Inc.*, 21 F.3d 1068, 30 USPQ.2d 1377 (Fed. Cir. 1994); *In re Fine*, 837 F.2d 1071,

5 USPQ.2d 1596 (Fed. Cir. 1988); *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); and *In re Merck & Co., Inc.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

The courts, however, further require that even if the prior art may be modified as suggested by the Examiner, the modification is not made obvious unless the prior art suggests the desirability of the modification, as was decided in *In re Fritch*, 922 F.2d 1260, 23 USPQ.2d 1780 (Fed. Cir. 1992), where the court held:

"The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. *In re Gordon*, 733 F.2d at 902, 221 USPQ at 1127."[at 1783] [Emphasis added]

In properly applying the *Graham v. John Deere Co.* test in light of, *inter alia*, *In re Jones*, *Gambro Lundia AB v. Baxter Healthcare Corporation*, and *In re Fritch*, discussed *supra*, the Examiner must conduct a rigorous examination and analysis of the prior art. It would appear that the Examiner has not done so.

Neither Smith nor Castiglia *et al.* make any motivating suggestion that, *inter alia*:

1. Regarding amended claims 2 and 6, the current carrying rods of Smith can be modified to be provided with the ornaments with resilient current carrying clasps which engage and electrically connect with the current carrying rods

of Castiglia *et al.*, as suggested by the Examiner, let alone the desirability of such a modification.

2. Regarding new claim 12, the decorative display of Smith can be modified to be provided with the low voltage transformer of Castiglia *et al.*, as suggested by the Examiner, let alone the desirability of such a modification.

The Examiner has directed the patentability inquiry towards the individual elements of the combination of the claimed invention and not to the subject matter as a whole, as required by the decision in *Panduit Corp. v. Burndy Corporation et al.*, 180 USPQ 498 (District Court, N.D. Illinois, E. Div.), where the court held:

"The inquiry into the patentability must be directed toward the subject matter as a whole and not to the elements of the claimed combination and their individual novelty, and therefore a patented combination which results in a more facile, economical or efficient unit, or which provides results unachieved by prior art structures, cannot be anticipated piecemeal by showing that the various elements of the invention are individually old.

The difference between the subject matter set forth in the Re. 26,492 patent and the subject matter of the cited prior art references as a whole would not have been obvious at the time the invention was made to a person of ordinary skill in the art to which such subject matter pertains, under 35 U.S.C. 103."[at 505] [Emphasis added]

Such a combining of elements in a piecemeal manner in light of applicant's disclosure to show obviousness by the Examiner using applicant's own specification

as though it were prior art is improper hindsight reasoning, and as such, is a direct violation of the basic mandate inherent in 35 U.S.C. § 103, as was decided in *In re Stephens, Wenzl, and Browne*, 145 USPQ 656 (CCPA 1965), where the court reversed a rejection on a combination of references and held:

"In our consideration of the record in light of appellants' arguments, we find nothing which demonstrates that the examiner and the board erred in rejecting the claims. While we agree with appellants that references may not be combined indiscriminately and with guidance from appellants' disclosure to show that claims are unpatentable, we think the combination of references here is proper and adequately suggests the structure appellants have achieved."[at 657]
[Emphasis added]

And, as was upheld in *In re Kamm and Young*, 172 USPQ 298 (CCPA 1972), where the court held:

"The rejection here runs afoul of a basic mandate inherent in section 103 - that a 'piecemeal reconstruction of the prior art patents in the light of appellants' disclosure' shall not be the basis for a holding of obviousness. *In re Rothermel*, 47 CCPA 866, 870, 276 F.2d 393, 396, 125 USPQ 328, 331 (1960)"[at 301]
[Emphasis added]

Support for the Examiner's improper use of hindsight to combine the references regarding amended claims 2 and 6 can be found at page 3, ¶ 1, lines 7-8 of the Office Action, where it is disclosed:

“...for the purpose of providing detachable electrical ornaments.” [Emphasis added]

Applicant has exhausted the use of this advantage explicitly and/or inherently throughout the application as originally filed, thus providing *prima facie* proof of the Examiner’s use of improper hindsight. For example at page 1, lines 1-6 of the application it is disclosed:

“The invention relates to a decorative lighting system and in particular, to an apparatus for mounting removable low voltage incandescent lights....”[Emphasis added]

Let’s say hypothetically, however, that there is a motivating suggestion that the current carrying rods of Smith can be modified to be provided with the ornaments with resilient current carrying clasps which engage and electrically connect with the current carrying rods of Castiglia *et al.*, as suggested by the Examiner and which applicant does not contend as discussed *supra*, a holding of obviousness can still not be made out because modifying the current carrying rods of Smith to be provided with the ornaments with resilient current carrying clasps which engage and electrically connect with the current carrying rods of Castiglia *et al.* would prevent Smith from functioning in its intended manner, and rearrangement of a prior-art device that prevents the device from functioning in the intended manner cannot be used for a holding of obviousness, as was decided in the Board of Appeals decision in *Ex parte Weber*, 154 USPQ 491, where the Board held:

"Claims are not rejected for obviousness since rearrangement of prior machine would so alter its construction and mode of operation that it would not function in its intended manner."[Emphasis added]

It is the intended manner of functioning of the tree of Smith to be able to utilize any ornaments, lights, and decorations that can be utilized by any other ornamental tree *i.e.* the tree of Smith is intended to use standard ornaments, lights, and decorations as discussed at col. 6, lines 1-7 of Smith, where it is disclosed:

"Any ornaments which could be added to any ornamental tree such as a Christmas tree can be added to this artificial tree. Any other lights which may be desired, which may be physically added to any other ornamental tree, may be added to this tree. Any type of decoration which may be added to any tree may be added to this tree."[Emphasis added]

Smith accomplishes this by passing wires through hollow branches as shown in **FIGURE 4** of Smith and as discussed at col. 2, lines 25-26 and claim 7, lines 1-3 of Smith, respectively, where it is disclosed:

"...each set of the sets of branches may be hollow enabling electrical wiring to pass therein."[Emphasis added]

"...each branch of said sets of branches [is] hollow enabling electrical wiring to pass therein."[Emphasis added]

If the hollow branches having wires passing therein of Smith were modified to be provided with the ornaments with resilient current carrying clasps which engage and electrically connect with the current carrying rods of Castiglia *et al.*, as suggested by the Examiner, any ornaments, lights, and decorations that can be utilized by any other ornamental tree would not be able to be utilized by the tree of Smith, *i.e.*, the tree of Smith would not be able to use standard ornaments, lights, and decorations as is required for its intended manner of functioning as discussed *supra*.

Quod erat demonstrandum, modifying the current carrying rods of Smith to be provided with the ornaments with resilient current carrying clasps which engage and electrically connect with the current carrying rods of Castiglia *et al.*, as suggested by the Examiner, would prevent Smith from functioning in its intended manner and therefore pursuant to *Ex parte Weber* discussed *supra* cannot be used for a holding of obviousness.

Regarding new claim 15, pursuant to 37 CFR § 1.111(c), new claim 15 discloses the following advantageous distinctive feature that distinguishes over and avoids the prior art:

“said at least one vertical support
frictionally engages said base at said at
least one aperture”[Emphasis added]

When the lighting system for conducting an electrical current of new claim 15 is designed in accordance with the advantageous distinctive feature of new claim 15 discussed *supra*, the system has the following advantages, *inter alia*:

1. The vertical support (trunk) is easily attached to the base by merely slipping the vertical support into the aperture of the base without having to align threads of the vertical support and the base and rotate the vertical support and the base relative to each other, especially since the plurality of current carrying rods (branches) can be easily removed from the apertures of the vertical support first and therefore be out of the way when attaching the vertical support to the base.
2. The vertical support (trunk) is easily removed from the base by merely slipping the vertical support out of the aperture of the base without having to rotate the vertical support and the base relative to each other, especially since the plurality of current carrying rods (branches) can be easily removed from the apertures of the vertical support first and therefore be out of the way when removing the vertical support from the base.

With further reference to Smith, and in further contradistinction, Smith does not teach “said at least one vertical support frictionally engages said base at said at least one aperture”[Emphasis added] as required by the advantageous distinctive feature of new claim 15 discussed *supra*, but rather Smith teaches that the tree section 7 [relied upon as a vertical support of new claim 15] threadably engages the base at the female electrical socket 5 [relied upon as the aperture of new claim 15]

thereof as shown in **FIGURE 1** of Smith and as discussed at col. 2, line 66 to col. 3, line 6 of Smith, where it is disclosed:

“The base further comprises a female electrical socket **5** which serves as a physical and electrical connection to any tree section with a male connector which might be screwed therein. A tree section with center shaft **7** may be screwed into socket **5** by the use of male connector **6** which would serve as a physical and electrical connection.”[Emphasis added]

This arrangement of Smith has the following disadvantages, *inter alia*:

1. The tree section is not easily attached to the base because to do so requires alignment of the threads of the tree section and the base and then rotating the tree section and the base relative to each other, especially with the cumbersomeness created by the branches remaining attached to the tree section and the linkage that movably attaches the branches to the tree section remaining attached and being movable and therefore not being out of the way when attaching the tree section to the base.
2. The tree section is not easily removed from the base because to do so requires rotation of the tree section and the base relative to each other, especially with the cumbersomeness created by the branches remaining attached to the tree section and the linkage that movably attaches the branches to the tree section remaining attached and being movable and therefore not being out of the way when removing the tree section from the base.

Regarding new claim 18, pursuant to 37 CFR § 1.111(c), new claim 18 discloses the following advantageous distinctive feature that distinguishes over and avoids the prior art:

“said plurality of current carrying rods frictionally engage said at least one vertical support at said plurality of apertures thereof”[Emphasis added]

When the lighting system for conducting an electrical current of new claim 18 is designed in accordance with the advantageous distinctive feature of new claim 18 discussed *supra*, the system has the following advantages, *inter alia*:

1. The plurality of current carrying rods (branches) are easily attached to the at least one vertical support (trunk) by merely slipping the plurality of current carrying rods into the plurality of apertures of the at least one vertical support (trunk) without having to utilize any attachment elements.
2. The plurality of current carrying rods (branches) are easily removed from the at least one vertical support (trunk) by merely slipping the plurality of current carrying rods out of the plurality of apertures of the at least one vertical support, thereby not compromising the structural integrity of the tree.

With further reference to Smith, and in further contradistinction, Smith does not teach “said plurality of current carrying rods frictionally engage said at least one vertical support at said plurality of apertures thereof”[Emphasis added] as required by the advantageous distinctive feature of new claim 18 discussed *supra*, but rather Smith teaches that the branches **20-27**, **51-58**, and **69-72** [relied upon as the

plurality of current carrying rods of new claim 18] must use nonconducting wires **90** to be attached to the center shafts **7**, **49**, and **68** [relied upon as the at least one vertical support of new claim 18] as shown in **FIGURE 4** of Smith and as discussed at col. 5, lines 38-42 of Smith, where it is disclosed:

“Circular nonconducting wire **90** in slip ring **48** passes through hole **88** in branch **58** to secure the branch to the center shaft **49**. Circular nonconducting wire **90** passes through hole **89** in branch **54** to secure branch **54** to center shaft **49**.”
[Emphasis added]

This arrangement of Smith has the following disadvantages, *inter alia*:

1. The branches are not easily attached to the trunk because to do so requires circular nonconducting wires to be passed through the branches and around the trunk, thereby utilizing an attachment element.
2. The branches are not easily removed from the trunk because to do so requires severing of the circular nonconducting wires, thereby compromising the structural integrity of the tree.

Applicant has provided clear and convincing evidence that neither Smith nor Castiglia *et al.* accomplishes applicant's result of providing an efficient lighting system for conducting an electrical current that, *inter alia*:

1. Eliminates a need for snaking loose wires through the at least one vertical support (trunk).

2. Eliminates a need for physically splicing the plurality of current carrying rods (branches) to the current carrying conductors in the at least one vertical support.
3. Eliminates loose wires in the at least one vertical support to deal with.
4. Provides easy attachment of the vertical support to the base by merely slipping the vertical support into the aperture of the base without having to align threads of the vertical support and the base and rotate the vertical support and the base relative to each other, especially since the plurality of current carrying rods can be easily removed from the plurality of apertures of the vertical support first and therefore be out of the way when attaching the vertical support to the base.
5. Provides easy removal of the vertical support from the base by merely slipping the vertical support out of the aperture of the base without having to rotate the vertical support and the base relative to each other, especially since the plurality of current carrying rods can be easily removed from the plurality of apertures of the vertical support first and therefore be out of the way when removing the vertical support from the base.
6. Provides easy attachment of the plurality of current carrying rods to the at least one vertical support by merely slipping the plurality of current carrying rods into the plurality of apertures of the at least one vertical support without having to utilize any attachment elements.
7. Provides easy removal of the plurality of current carrying rods from the at least one vertical support by merely slipping the plurality of current carrying rods out of the plurality of apertures of the at least one vertical support, thereby not compromising the structural integrity of the tree.

Therefore, a holding of obviousness cannot be made out, as was decided in *In re Wright*, 122 USPQ 522 (1959), where the court held:

"We need not elaborate upon the rule that a novel combination of old elements which so cooperate with each other so as to produce a new and useful result or a substantial increase in efficiency, is patentable."[at 525][Emphasis added]

And, as was upheld in the Board of Appeals decision in *Ex parte Tanaka, Marushima and Takahashi*, 174 USPQ 38, where the Board held:

"Claims are not rejected on the ground that it would be obvious to one of ordinary skill in the art to rewire prior art devices in order to accomplish applicant's result...."
[Emphasis added]

In this same regard, the Examiner's attention is respectfully directed to the decisions in *In re Halleck*, 164 USPQ 647 (CCPA 1970); and *Kockum Industries, Inc. v. Salem Equipment, Inc.*, 175 USPQ 81 (9th Cir. 1972).

In view of, *inter alia*, *Altiris, Inc., v. Symantec Corp.*, *CCS Fitness, Inc. v. Brunswick Corp.*, *In re Chu*, *In re Dailey and Eilers*, *In re Deuel*, *Richardson-Vicks Inc. v. The Upjohn Co.*, the *Graham v. John Deere Co.* test in light of, *inter alia*, MPEP § 706.02, *In re Jones*, *Gambro Lundia AB v. Baxter Healthcare Corporation*, *Heidelberger Druckmaschinen AG v. Hantscho Commercial Products, Inc.*, *In re Fine*, *In re Keller*, and *In re Merck & Co., Inc.*, *In re Fritch*, *Panduit Corp. v. Burndy Corporation et al.*, *In re Stephens*, *Wenzl*, and *Browne*, *In re Kamm and Young*, *Ex*

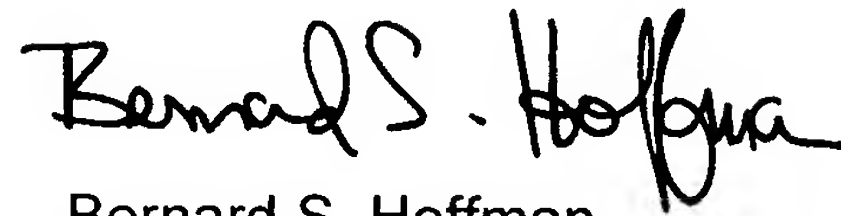
parte Weber, In re Wright, Ex parte Tanaka, Marushima and Takahashi, In re Halleck, and Kockum Industries, Inc. v. Salem Equipment, Inc., discussed *supra*, applicant attacks the Examiner's *prima facie* determination as being improperly made out and tending to support a conclusion of nonobviousness as is permitted by *In re Fritch* at 1783, where the court further held:

"In proceedings before the Patent and Trademark Office, the Examiner bears the burden of establishing a *prima facie* case of obviousness based upon the prior art....[The Examiner] can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references. The patent applicant may then attack the Examiner's *prima facie* determination as improperly made out, or the applicant may present objective evidence tending to support a conclusion of nonobviousness."[Emphasis added]

In view of the amendments made *supra* to claims 1-6 and 11, the addition of new claims 12-19, and the arguments presented *supra*, applicant respectfully submits that the Examiner's grounds for the rejection of claims 1-6 and 9-11 under 35 U.S.C. § 103(a) as being unpatentable over Smith in view of Castiglia *et al.* are no longer applicable and applicant therefore respectfully requests that this rejection be withdrawn.

In view of the above, it is submitted that the claims are in condition for allowance. Reconsideration and withdrawal of the rejection and objection and allowance of claims 1-20 at an early date are earnestly solicited.

Respectfully submitted,



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